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EXAMINER

HAYES, J

ART UNIT

PAPER NUMBER

2161

DATE MAILED:

04/12/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Application No.

09/476,334

Applicant(s)

SAITO, MAKOTO

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 71-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 71-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/536,747.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. Applicant has canceled claims 2-70 upon the filing of the continuation application on 3 January 2000. Applicant has further canceled claim 1 and added new claims 71-80 in the preliminary amendment filed 12 March 2001. Thus, claims 71-80 are the only claims remaining in the application and are presented for examination.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the steps of encrypting, decrypting and re-encrypting the data by a copyright control program as recited in claims 71-74, a copyright control program stored in a ROM or operating system of a user terminal as recited in claims 75-78 and adding copyright information to the unencrypted, encrypted decrypted and re-encrypted data as recited in claims 79-80 must be shown in the drawings or the feature(s) canceled from the claim(s). No new matter should be entered.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 71-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claims 71-74, the phrase "and/or" renders the claim indefinite because it is unclear which limitation(s) are part of the claimed invention. See MPEP § 2173.05(d).

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6. Claims 79 and 80 recite the limitation "said copyright information" in the body of the claims.

There is insufficient antecedent basis for this limitation in these claims.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 71-72 and 79-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al, U.S. Patent No. 5,465,299 in view of Shanton, U.S. Patent No. 5,369,702.

As per claim 71, Matsumoto et al disclose an electronic document processing system using digital signatures and teaches a method of encrypting unencrypted data using a first secret key (Col. 3, lines 1-5 and 19-28; Col. 6, lines 7-16; Col. 8, lines 40-47; Col. 9, lines 34-60) of a first user, supplying the encrypted data to a another user and decrypting the encrypted data using the public key of the first user (Col. 4, lines 18-31; Col. 6, lines 7-16; Col. 7, lines 30-33), displaying the decrypted data (Col. 6, lines 36-44; Col. 8, lines 9-13), re-encrypting the decrypted data using a second secret key (Col. 3, lines 19-28; Col. 6, lines 7-16; Col. 11, lines 16-33) and storing, copying or transferring the re-encrypted data to another user (Col. 3, lines 19-28; Col. 8, lines 40-47; Col. 9, lines 50-59). Matsumoto et al disclose the use of a public key to decrypt the data being received by another user, however, fail to disclose that the same secret key is used for encryption and decryption. Shanton discloses a system for increasing the security of a computer system and teach that it is known that a secret cryptographic key would be used by two people in order to communicate confidential information (Col. 1, line 45-Col. 2 line 15). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Matsumoto et al and include the use of the same secret key for both encryption of data by a first user and decryption of the data by a second user. This would enable successful confidential

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communication between two users and would prevent access to the data by unauthorized persons who do not have possession of the secret key (See Shanton, Col. 2, lines 5-10).

As per claim 72, Matsumoto et al further disclose editing the decrypted data, encrypting the edited data using a second secret key and storing the edited data, copying the encrypted edited data or transferring the encrypted edited data to a secondary user (Col. 3, lines 19-28; Col. 8, lines 40-48; Col. 9, lines 34-60).

As per claim 79, Matsumoto et al further disclose adding copyright information in the form to version management information to the unencrypted data, the encrypted data, the decrypted data and the re-encrypted data (Col. 3, lines 1-28 and 47-62; Col. 4, lines 5-31)

As per claim 80, Matsumoto et al further disclose adding copyright information to the encrypted edited data (Col. 3, lines 1-28 and 47-62; Col. 4, lines 5-31).

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 71-80 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,069,952. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 1-4 of U.S. Patent No. 6,069,952 recite all the limitations of claims 71-80, however, claims 1-4 of U.S. Patent No. 6,069,952 differs since they further recite additional claim limitations decrypting the re-encrypted data again using the second secret key when the re-encrypted data which has been stored, copied or transferred is used.

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However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of U.S. Patent No. 6,069,952 by removing certain limitations in order to make the claim more broad and result in the invention as claimed in claims 71 of the present application in an attempt to attain more broad patent protection for the invention.

### ***Allowable Subject Matter***

11. Claims 73-78 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and are amended to overcome the 35 U.S.C. 112 rejections and Double Patenting rejections discussed above.

12. The following is a statement of reasons for the indication of allowable subject matter: As per claims 73-78, the prior art of record when taken either individually or in combination with other prior art of record fails to teach or suggest the use of a copyright control program to carry out the recited steps of encrypting, decrypting and re-encrypting using first and second secret keys.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Grundy discloses a method and system for decentralized manufacture of copy-controlled software
- Halter et al disclose a method and system for securely distributing a plurality of software files from a distributor to a user
- Nagahama discloses the use of encryption techniques for licensing to use software products that are sold on a piece by piece basis
- Newell discloses a system for preventing unauthorized copying of recorded information
- Matyas et al [EP 0191162 A2] disclose a method of software protection wherein encryption keys are used so that software can be run only on designated computers or by users possessing a designated smart card.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

The Fax phone number for the **UNOFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 305-0040 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

The Fax phone number for the **OFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 308-9051 or 9052 (for formal communications intended for entry).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

John Hayes

06 April 2001



**JAMES P. TRAMMELL**  
**SUPERVISORY PATENT EXAMINER**  
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